

Application No.: 09/391,250

Docket No.: 520.37546X00

REMARKS

Reconsideration and allowance of this application, as amended, is respectfully requested.

This Amendment is in response to the Office Action dated December 18, 2003. By the present Amendment, claims 14-18 and 29, which have now been indicated as being directed to a non-elected embodiment, have been cancelled, without prejudice to the Applicants' right to file a Divisional application directed to these claims.

Reconsideration and allowance of the remaining claims 1-4, 7-11 and 30-33 over the cited prior art to Hartner and Okudaira is respectfully requested. With regard to this, the Office Action recognizes that:

"Hartner, et al. does not explicitly teach . . . thicknesses of diffusion barrier and action barrier are substantially the same."

However, notwithstanding this, the Office Action goes on to state (in the second full paragraph on page 4 thereof) that:

"It would have been obvious to one of ordinary skill in the art to provide the thicknesses of diffusion barrier and reaction barrier film being substantially the same as claimed by routine experimentation."

Beginning at the bottom of page 4 of the Office Action, it is further stated:

"Applicants argue that applied arts do not teach the thicknesses of diffusion barrier and reaction barrier film are substantially the same. In response, as above discussion, one of ordinary skill in the art to provide the thicknesses of diffusion barrier and reaction barrier film being substantially the same as claimed by routine experimentation. Moreover, Applicants do not provide any evidence that the thicknesses of diffusion barrier and reaction barrier film have to be substantially the same in order to obtain an unexpected result or these thicknesses are critical in the present invention."

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In response to this, Applicants respectfully request the Examiner to review the provisions recently incorporated into MPEP 2144.03 regarding "reliance on common knowledge in the art or "well known" prior art." More specifically, on page 2100-132, under the heading "B," it is specifically stated:

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge."

With regard to this, reference is made to the cases of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) and In re Zurko, 50 USPQ 2d 1693 (Fed. Cir. 2001). More specifically, the MPEP goes on to note:

"Holding the general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these finds will not support an obviousness rejection."

The MPEP goes on to note in this section that certain older cases permitted reliance on common knowledge without specific reliance on documentary evidence. However, the MPEP now states:

"If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide some specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge."

It is respectfully submitted that these sections of the MPEP apply to the situation presented by the present case. Specifically, the Examiner has recognized that there is no teaching or suggestion in the cited prior art for the claimed feature of the thicknesses of the diffusion barrier and reaction barrier film being substantially the same. However, it has merely broadly been asserted in the Office Action that this could be arrived at by "routine experimentation." However, no "specific factual

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finding predicated on sound technical and scientific reasoning" has been provided in the Office Action concerning this.

Instead, a general statement has been made that there is no evidence of "unexpected results" regarding these thicknesses being critical to the present invention. In the first place, it is noted that the cases cited in the MPEP in § 2144.03 do not require any such unexpected results. Besides this, providing the substantial equal thicknesses for these two layers provides a substantially improved planar upper surface for the combined layers, thereby leading to an improved product. As apparently recognized by the Examiner, there is simply no teaching or suggestion for either the structure or this advantage in the cited prior art. As set forth in the case of In re Lee, concerning motivation for modification or combination of a reference:

"This factual question of motivation is material to patentability, and could not be resolved on subject belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been lead to this combination of references, simply to "use that which the inventor taught against it teacher."

In the present instance, there is no motivation whatsoever for making the modification to provide the admittedly unmet limitation except a claim of "routine experimentation." It is respectfully submitted that this is the exact type of "subjective belief and unknown authority" prohibited in the case of In re Lee, and now prohibited by the MPEP as well.

Beyond this, as also noted in MPEP 2143.01 on page 2100-126,:

"The mere fact that reference can be combined or modified does not render the result and combination obvious unless the prior art also suggests the desirability of the combination."

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Similarly, in the case of In re Fine, also cited in the MPEP 2143.03 under the heading "All claim limitations must be taught or suggested" specifically states:

"The Eads and Warnick references disclose, at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability." 5 USPQ 2d at 1599.

As such, it is respectfully submitted that the "routine experimentation" suggested in the Office Action is really no more than a statement that it would be "obvious to try" the invention, which is clearly not the test of patentability, as recognized by both the MPEP and the Courts.

For the reasons set forth above, reconsideration and allowance of claims 1-4, 7-11 and 30-33 over the cited prior art to Hartner and Okudaira is respectfully requested.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of

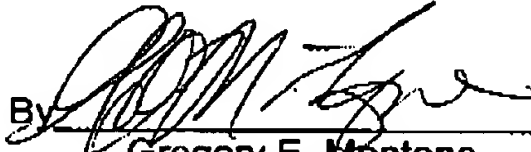
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this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Docket No. 520.37546X00), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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